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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/655,252	09/05/2000	Lee Cannon	100-114P2	7732

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EXAMINER
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COBURN, CORBETT B

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 03/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/655,252

Applicant(s)

CANNON ET AL.

Examiner

Corbett B. Coburn

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 48-50 and 53-126 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 48-50 and 53-126 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Art Unit: 3714

DETAILED ACTION

*Response to Amendment*

1. The objection to claim 49 has been overcome by amendment and is hereby withdrawn.
2. The rejection of claims 65, 66 & 99 under 35 USC §112 has been overcome by amendment and is hereby withdrawn.

*Claim Rejections - 35 USC § 112*

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 53-56 & 86-89 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for providing a ticket when a player has lost a number of games, does not reasonably provide enablement for providing a ticket when a player has lost a number of games while at the same time not providing the ticket based on a cumulative result of a plurality of outcomes. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with these claims. The limitations are in direct contradiction to each other. It is not possible to both award a ticket base on a number of losses and award a ticket not based on the cumulative result of a plurality of outcomes.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 53-56 & 86-89 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

Art Unit: 3714

applicant regards as the invention. As pointed out immediately above, these claims have a limitation that directly contradicts a limitation in the independent claims. Examiner cannot determine the meaning of the claims and therefore cannot apply art to the claims.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 48-50, 59-63, 78-84, 92-97 & 111-122 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly et al. (US Patent Number 5,816,918) in view of Deaton et al. (US Patent Number 5,621,812).

**Claims 48, 84:** Kelly teaches a gaming device (10) with a currency receiver (14) being adapted to receive at least one medium of currency and a display device (56) being adapted to display indicia corresponding to an outcome of a wagering game (i.e., poker, blackjack, solitaire – Col 1, 28-29). The outcome of an occurrence of the wagering game is at least partially randomly determined. There is a first output device (20) adapted to dispense a gaming award based on the occurrence of a predetermined winning outcome during the occurrence of the wagering game after depositing at least a minimum amount of the at least one medium of currency in the currency receiver (Abstract). There is a second output device (22) being adapted to dispense a ticket after the occurrence of a triggering event. The ticket might be a promotional coupon that can encourage the player

Art Unit: 3714

to return to the current gaming location in the future. (Col 8, 61-63) The ticket is referred to as a prize, however, and may be considered to be a gaming award.

Deaton teaches a device for providing a ticket to a patron to reward frequent customers or to encourage infrequent customers to become frequent customers. Deaton discloses issuing coupons base on the customer's history of shopping with the establishment and not as a gaming award. Deaton's triggering event is not the occurrence of a predetermined winning outcome of a wagering game or the cumulative result of a plurality of outcomes. Deaton does not award a coupon for every transaction. Deaton makes it clear that the coupons are awarded based on the customer's history of shopping in the establishment. (Figs 17A & B)

It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kelly in view of Deaton to issue tickets that are not a gaming award upon the occurrence of a triggering event that is not the occurrence of a predetermined winning outcome of a wagering game or the cumulative result of a plurality of outcomes or every transaction (i.e., every occurrence of the wagering game) in order to encourage the player to return to the current gaming location in the future.

**Claim 49:** Kelly teaches that the system may be applied to slot machines. (Col 3, 44) Slot machines have at least one reel display.

**Claim 50:** Fig 2 clearly shows that display device (56) is a video display.

**Claims 59, 92, 93:** Kelly teaches the use of smart cards and user validation/verification. (Col 6, 46-56) This is equivalent to a user-tracking card.

Art Unit: 3714

**Claims 60, 94:** Kelly teaches the tickets dispensed by the output device may be promotional tickets. (Col 8, 61-63) Deaton also teaches promotional tickets (coupons).

**Claims 61, 95:** Kelly teaches the tickets dispensed by the second output device may be redeemable for one occurrence of the wagering game. (Col 8, 60)

**Claims 62, 96:** Kelly teaches that prizes are “any merchandise, souvenir, food item, or other physical goods or services which can be offered to players”. (Col 8, 55-56) Kelly specifically teaches that a free game is a prize. (Col 8, 60) An occurrence of a second wagering game on a second gaming device is a service that can be offered to players.

Therefore, Kelly teaches the tickets dispensed by the second output device may be redeemable for one occurrence of a second wagering game on a second gaming device.

**Claims 63, 97:** Kelly teaches that prizes are “any merchandise, souvenir, food item, or other physical goods or services which can be offered to players”. (Col 8, 55-56) Thus, the tickets dispensed by the second output device are redeemable for services provided by a gaming establishment.

**Claims 78, 111:** Kelly teaches that the tickets are redeemable for prizes. Thus, the tickets are different in form from the gaming award. Furthermore, Kelly teaches that the game award may take the form of cash issued by the machine. (Col 8, 7-9) This is different in form than the tickets issued.

**Claim 79:** The first output device comprises a printer. (Col 10, 30-35)

**Claims 80, 112:** Fig 2 shows the printer prints indicia corresponding to at least one of a plurality of signals generated at a location remote from the gaming device. In this case, the printer (50) is remote from the game device (10).

Art Unit: 3714

**Claims 81, 113:** The plurality of signals are generated by a gaming establishment. The game machine (10) generates the signals and it belongs to a gaming establishment.

**Claims 82, 83, 114, 115:** Kelly teaches the plurality of signals are generated in direct response to operator input -- operation of the "Collect Prize" button (286) by the player.

**Claim 116:** Kelly teaches providing a player with an opportunity to place a wager and to play the wagering game at the wagering device, wherein the outcome of each occurrence of the wagering game is at least partially randomly determined. (Abstract) Kelly teaches accumulating points for the player as the player plays the wagering game and displaying a visible indication (125) of the player's accumulated points at the gaming device and providing the player with the opportunity to redeem at least a portion of the accumulated points at the gaming device via an input device. (Abstract) Kelly also teaches that the gaming device may be used for promotional uses – i.e., comps. (Col 6, 61-63) In that situation, the points accumulated by the player would be comp points. Deaton also teaches awarding comps (i.e., discount coupons) based on the frequency of visits by a patron. These comp points are not determined by the outcome of the randomly determined wagering game or by skill of the player. Deaton teaches that this helps increase the frequency of customer visits, thus increasing profits. (Col 64, 39 – Col 67, 30) It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kelly in view of Deaton to award comp points that are not determined by the outcome of the randomly determined wagering game or by skill of the player in order to increase the frequency of customer visits, thus increasing profits.

Art. Unit: 3714

**Claims 117, 121:** Kelly teaches displaying at least one redemption option to a player at the gaming device. (Fig 6b)

**Claim 118:** Fig 6b shows highlighting one of the prizes and checking a box. This is changing the display of the at least one redemption option of the gaming device.

**Claim 119:** A player has to provide input in order to play the game and accumulate comp points. Thus player input at the gaming device is required prior to displaying the player's accumulated comp points.

**Claim 120:** In order to redeem points, the player must provide input to make a selection of the prize. (Fig 6b)

**Claim 122:** Kelly teaches printing tickets redeemable for goods and services. (Col 8, 55-56)

8. Claims 57, 58, 90 & 91 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly and Deaton as applied to claim 48 or 84 above, and further in view of Harlick (US Patent Number 5,941,773).

**Claims 57, 58, 90 & 91:** Kelly and Deaton teach the invention substantially as claimed but do not teach the triggering event being a randomly determined occurrence of a wagering game or a randomly determined time. Harlick teaches awarding a bonus based on a randomly determined occurrence of a wagering game (Fig 2) or a randomly determined time (Fig 3). Harlick teaches that this scheme will induce players to play the games. (Col 1, 9-10) It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kelly and Deaton the triggering event be a



Art. Unit: 3714

randomly determined occurrence of a wagering game or a randomly determined time in order to induce players to play the game.

9. Claims 64, 98 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly and Deaton as applied to claim 48, 84 above, and further in view of Harrison (US Patent Number 5,934,671).

**Claims 64, 98:** Kelly and Deaton teach the invention substantially as claimed but do not teach the award of scratch-off tickets. Harrison teaches scratch-off tickets. Scratch-off tickets are well known to the art and are often used as promotional tickets. Having a scratch-off ticket prolongs the player interest in the game because it adds another step to the game. It would have been obvious to one of ordinary skill in the art at the time of the invention to have issued Kelly's and Deaton's promotional tickets in the form of Harrison's scratch-off ticket in order to prolong the player interest in the game by adding another step to the game.

10. Claims 65, 66, 99 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly and Deaton as applied to claim 48 above, and further in view of Baerlocher et al. (US Patent number 5,788,573).

**Claims 65, 66, 99:** Kelly and Deaton teach the invention substantially as claimed, but do not teach a secondary gaming unit with a wheel to display randomly generated indicia and a gaming award dispensed upon occurrence of a winning secondary outcome. Baerlocher teaches use of a secondary gaming unit in the form of a wheel to display randomly generated indicia and a gaming award dispensed upon occurrence of a winning secondary outcome. (Fig 4) Bonus games are well known to the art and are known to

Art Unit: 3714

attract players. It would have been obvious to one of ordinary skill in the art to have modified Kelly and Deaton in view of Baerlocher to have a secondary display in the form of a wheel to display randomly generated indicia and a gaming award dispensed upon occurrence of a winning secondary outcome in order to provide a bonus game that attracts players.

11. Claims 67-77, 100-110 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly and Deaton as applied to claim 48 above, and further in view of Mullins (US Patent Number 5,158,293).

**Claims 67-70, 100-103:** Kelly and Deaton teach the invention substantially as claimed. Kelly teaches dispensing a ticket that can be redeemed for prizes. Kelly teaches that prizes are “any merchandise, souvenir, food item, or other physical goods or services which can be offered to players”. (Col 8, 55-56) Kelly also teaches that tickets may be redeemed for a free game. (Col 8, 60) Kelly does not, however, specifically teach that the ticket may also be redeemed for an entry in a drawing, though such a ticket would be within Kelly’s definition of a prize. Mullins teaches a lottery ticket that may be used in a drawing. Lotteries are extremely popular with both players and casinos. Players find lotteries exciting for the same reason casinos like them -- lotteries can offer large prizes. However, some players prefer a certain payout since lotteries have such poor odds of winning. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kelly and Deaton in view of Mullins to dispense tickets be redeemable for one occurrence of the wagering game and entries in a drawing in order to

Art. Unit: 3714

take advantage of the popularity of lotteries while, at the same time giving the player a certain payout in the form of a free game.

**Claims 71, 74, 104:** Mullins teaches an embodiment with means for receiving a player's selection of at least one indicia from a predetermined set of indicia for the drawing. (Col 5, 12-15)

**Claims 72, 105:** Mullins teaches randomly selecting the indicia. (Col 3, 59-61) The indicia are randomly assigned to the user, therefore the gaming unit selects the indicia.

**Claims 73, 106:** Mullins teaches that the indicia are numbers. (Col 3, 59-61)

**Claims 75, 108:** Mullins teaches allowing the player to choose indicia for a drawing-type lottery. (Col 5, 12-15) Mullins is silent concerning how these indicia are entered into the device. Keypads are well-known devices for data entry. Kelly teaches a keyboard input device. (Col 7, 4-9) A keyboard is a keypad.

**Claims 76, 109:** Kelly teaches a touch screen input device. (Col 7, 7)

**Claims 77, 110:** Mullins teaches that the indicia are numbers. (Fig 5)

12. Claims 123-126 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly and Deaton as applied to claim 116 above, and further in view of Boushy (US Patent Number 5,761,647).

**Claims 123-126:** Kelly and Deaton teach the invention substantially as claimed. Kelly teaches allowing the player to accumulate comp points, but does not go into the details. Boushy teaches accumulating a plurality of comp values according to different comp criteria. (Col 5, 16-19) The comp values have corresponding comp awards. (I.e., The

Art. Unit: 3714

player gets more points for certain activities.) The player may continue to accumulate points even after the player has reached a comp value level that qualifies for an award.

All activities that are eligible for “comping” get an award of comp points for the player. As pointed out at Boushy’s Col 5, 16-19, some activities earn a larger award than others. Whenever a player participates in any of these activities, the player receives comp points – even if the player has already had an award of comp points.

“Comping” is well known to the art. It is a method of attracting repeat players and for awarding players non-monetary awards -- both of which increase casino profits. It would have been obvious to one of ordinary skill in the art at the time of the invention to have taken Kelly’s suggestion of awarding comps and fleshed it out using Boushy’s disclosure in order to have a complete comping system that attracts repeat players and for awards players non-monetary awards, thus increasing casino profits.

### *Response to Arguments*

13. Applicant's arguments with respect to claims 48-126 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (703) 305-3319. The examiner can normally be reached on 8-5:30, Monday-Friday, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3714

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
cbc



JESSICA HARRISON  
PRIMARY EXAMINER